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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,293	05/31/2001	G. Eric Engstrom	112076-138338	2368

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,293

Applicant(s)

ENGSTROM, G. ERIC

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant's "Response After Final Rejection" filed on February 22, 2006 has been considered.

Claims 1, 15, 22, and 29 are amended. Claims 1-37 remain pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claim 1-5, 7, 13-17, 19, 22-24, 26, 29-31, 34, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0254893 A1 to Tsuei et al.**

Regarding claims 1, 15, 22, and 29, Tsuei discloses an electronic delivery address service method, storage medium, an apparatus, and system comprising:

- the receiving by the delivery address service via electronic communication, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber (paragraph 237; paragraph 62; paragraph 21; paragraph 29; Figure 26);
- in response, the delivery address service the electronically generating the subscriber with a substitute delivery address (paragraph 29; paragraph 239);
- transmitting by the delivery address service the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good (paragraph 239; paragraph 232; paragraph 245; Figure 26);
- the receiving by the delivery address service an electronic notification of either a request to deliver or an arrival of the purchased goods in an online purchase of the goods (paragraph 26; paragraph 232; paragraph 246; Figure 26); and
- intervening by the delivery address service by electronically accessing and communicating the mailing address provided by the subscriber as part of the electronic subscription to a delivery service to facilitate delivery of the purchased goods to the subscriber at the mailing address of the subscriber , wherein the mailing address accessed and communicated by the delivery address service is retrieved from a database of said delivery address service (paragraphs 242-244; paragraph 246; paragraphs 26-27).

Regarding claims 2, 16, 23, and 30, Tsuei discloses the correlation of the substitute delivery address to the mailing address of the subscriber (paragraph 237; paragraph 239; paragraphs 26-27).

Regarding claims 3-5, 17, 24, and 31, Tsuei disclose the mailboxes and the mailbox proximately located with the mailing address of the subscriber (paragraph 235).

Regarding claims 7, 19, 26, 34, and 36, Tsuei discloses wherein the substitute delivery address comprises one of a plurality of virtual delivery address artificially created by the delivery address service (paragraph 29); and the providing the mailing address of the subscriber to the delivery service (paragraphs 242-244; paragraph 246; paragraphs 26-27).

Regarding claims 13-14, the subscriber is a purchaser of the goods or a beneficiary of the purchase (paragraph 29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 8-10, 12, 18, 20-21, 25, 27-28, 32-33, 35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0254893 A1 to Tsuei et al. in view of U.S. Patent No. 6,336,100 to Yamada.

Tsuei substantially discloses the claimed invention, however, it does not explicitly disclose the delivery address service notifying the subscriber of the arrival of the purchased goods; receiving a notification of a request to deliver a purchased good from a delivery service; confirmation by the delivery address service of the purchase; and

delivery address service receives the confirmation from an online business from which the goods to be delivered was purchased. Tsuei discloses a privacy mail delivery service (PMS) which is divided into Private Mail Administration Service (PMAS) and Private Mail Mapping Center (PMMC) (paragraph 237). PMAC is responsible for customer registration and subscription, billing, assignment of Private Mail codes, and customer service functions such as changes to delivery address, modifying account data, canceling subscriptions (paragraph 237). PMMC's main function is to provide shippers with the delivery address information associated with the Primate Mail code (paragraph 242). PMMC handles administration functions associated with the shippers (paragraph 242)

Yamada, on the other hand, teaches the delivery address service notifying the subscriber of the arrival of the purchased goods (col. 3, lines 43-48); receiving a notification of a request to deliver a purchased good from a delivery service (col. 3, lines 28-31; col. 3, lines 13-18); confirmation by the delivery address service of the purchase (col. 3, lines 13-18); and delivery address service receives the confirmation from an online business from which the goods to be delivered was purchased (col. 3, lines 28-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tsuei, to include the notification and confirmation, as taught by Yamada, in order to deliver and confirm that the commodity has been delivered to the customer's designation (Yamada, col. 3, lines 55-60).

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei and Yamada as applied to claims 10 above, and further in view of U.S. Patent No. 2002/0022967 to Ohkado.

Tsuei and Yamada substantially disclose the claimed invention, however, the combination does not explicitly disclose the delivery address service receives a confirmation from the subscriber.

Ohkado, on the other hand, teaches the delivery address service receives a confirmation from the subscriber (paragraph 65; paragraph 90).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the delivery address service receives a confirmation from the subscriber, in order to ensure the anonymity of customers during the delivery of purchases (Ohkado, paragraph 15).

Response to Arguments

5. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection. In addition, the Examiner notes that the new grounds of rejection in the instant action was necessitated by Applicant's amendment filed on 10/7/2005. Therefore, the instant office action is a final rejection of the claims.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (571) 272-6771. The examiner can normally be reached on Monday to Friday from 10:00 AM to 6:30 PM. If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771. The fax telephone number for this group is (571) 273-8300 (for official communications including After Final communications labeled "Box AF").

A handwritten signature in black ink, appearing to read 'Alexander Kalinowski', is positioned above the printed name.

Alexander Kalinowski

Supervisory Patent Examiner

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4/17/2006